The opinion in support of the decision being entered today was <u>not</u> written for publication in a law journal and is <u>not</u> binding precedent of the Board.
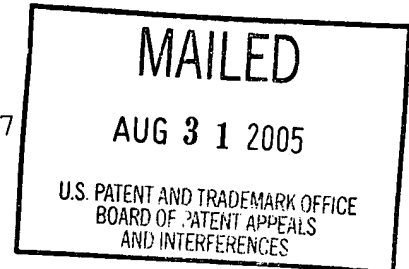
Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HEIKO H. LUDWIG and KEITH G. WHITTINGHAM

_____

Appeal No. 2004-1140
Application No. 09/433,427

_____

ON BRIEF

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Before HAIRSTON, GROSS, and LEVY, ***Administrative Patent Judges***.

GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 18, which are all of the claims pending in this application.

Appellants' invention relates to a method and system for interconnecting two server computers, each connected to at least one client computer, and each running a workflow management system. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of interconnecting a first server computer (112) of a service requestor (1) and a second server computer (122) of a

service provider (2), each of said first server computer (112) and said second server computer (122) being connected to at least one client computer (111, 121);

said first server computer (112) running a first workflow management system application (3), and said second server computer (122) running a second workflow management system application (4);

said method comprising providing a first and a second connector application (5a, 6a) for permitting said first server computer (112) access to a copy of said first connector application (5a) and for permitting said second server computer (122) access to a copy of said second connector application (6a);

wherein said copies of said first and said second connector application (5a, 6a) each comprises a connection agreement (8, 12) for a first work task (7) of a first workflow instance (18) encompassed by said first workflow management system application (3);

which copy of said first connector application (5a) further comprises a first mapping table (9) including a first service terminology (9a) and a common terminology (9b, 13b), and which copy of said second connector application (6a) further comprises a second mapping table (13) including a second service terminology (13a) and said common terminology (9b, 13b);

said first work task (7) being transposed by said first mapping table (9) from said first service terminology (9a) into an input data set (ip1, ip2) in said common terminology (9b,13b);

said input data set (ip1, ip2) being marshalled to said second server computer (122) over a common connection (17), and said marshalled input data set (ip1, ip2) being transposed to a second work task (15) by said second mapping table (13) from said common terminology (9b, 13b) into said second service terminology (13a), and said second work task (15) being processed by said second workflow management system application (4).

The prior art references of record relied upon by the

examiner in rejecting the appealed claims are:

Skeen et al. (Skeen)   5,557,798   Sep. 17, 1996
Bittinger et al. (Bittinger) 5,754,774   May 19, 1998
Khan et al. (Khan)   6,157,934   Dec. 05, 2000
                                                 (Filed Oct. 15, 1996)

Claims 1 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bittinger in view of Skeen and Khan.

Reference is made to the Examiner's Answer (Paper No. 14, mailed December 5, 2003) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 13, filed September 29, 2003) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 18.

The examiner admits (Answer, page 4) that Bittinger fails to disclose workflow management systems and first and second mapping tables, as recited in independent claims 1 and 10. However, the examiner contends that "these features are well known in the art and would have been an obvious modification to the system disclosed by Bittinger . . . as evidenced by Skeen . . . and

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Khan." The examiner relies on Skeen for the mapping tables and

Khan for the workflow management systems.

The examiner asserts (Answer, page 5) that "a person having

ordinary skill in the art would have readily recognized the

desirability and advantages of modifying Bittinger . . . by the

use of mapping tables for conversion, as disclosed by Skeen . . .

in order to allow for configuration changes by the end user or

system administrator without additional software development."

Similarly, the examiner states (Answer, page 5) that

> data exchange among workflow management systems is
> known in the art, a person having ordinary skill in the
> art would have readily recognized the desirability and
> advantages of applying Bittinger . . . to the workflow
> applications, such as disclosed by Khan . . . because
> it would have provided the function of passing workflow
> data among workflow management systems without
> requiring specific translation code in the workflow
> applications and permit the code to be separate from
> the core workflow applications so as to allow
> configuration changes without rewriting the workflow
> application.

Appellants argue (Brief, pages 16-17) that Khan "discloses a

server/client architecture (one server computer . . . and a

plurality of client computers) wherein a single workflow

application is processed." Appellants contrast that with the

claimed invention, which "relates to and provides an interface

between different workflow management systems (first server

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computer 112 and second server computer 122)." Appellants

contend (Brief, page 17) that the rejection is based on

impermissible hindsight. The examiner responds (Answer, page 11)

that Skeen and Bittinger "show a system for and the benefits of

the transfer of information between applications using different

data or communication formats in a variety of software

applications." Further, states the examiner (Answer, page 11),

Khan "was simply used to show the prevalence of workflow

management systems as a type of application that commonly

transmits information on a computer network," and "[w]orkflow

management systems are software applications and therefore would

benefit from this method of connection." We agree with

appellants that the rejection is based on impermissible

hindsight.

The Federal Circuit has held that "[t]he mere fact that the

prior art may be modified in the manner suggested by the Examiner

does not make the modification obvious unless the prior art

suggested the desirability of the modification." *In re Fritch*,

972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-4 n.14 (Fed. Cir.

1992), *citing In re Gordon*, 733 F.2d 900, 902, 221, USPQ 1125,

1127 (Fed. Cir. 1984). Further, a factual inquiry whether to

modify a reference must be based on objective evidence of record,

not merely conclusionary statements of the examiner. *See In re*

Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Here the examiner has pointed to nothing in the references that

would have suggested applying the workflow management system of

Khan to each of two servers in Bittinger. The examiner's basis

for combining the references appears to come out of thin air, not

from objective evidence of record.

We further note that although Skeen discloses (column 1,

lines 63-67) that using multiple formats "means that translations

either to a common language or from the language of one computer

or process to the language of another computer or process must be

made before meaningful communication can take place," there is no

indication that the two computers of Bittinger would require

such a translation. In fact, as the examiner pointed out,

Bittinger discloses (column 3, lines 36-45) that an HTTP data

stream is converted to a client/server specific communication

protocol and back to the HTTP data stream. Thus, there would

appear to be no need for two mapping tables, as recited in the

claims. Also, the examiner's reasoning for combining Skeen, as

with the motivation for combining Khan, does not appear to be

based on objective evidence from the record. Therefore, the

examiner has failed to establish a *prima facie* case of

obviousness, and we cannot sustain the obviousness rejection of claims 1 and 10 nor of their dependents, claims 2 through 9 and 11 through 18.

CONCLUSION

The decision of the examiner rejecting claims 1 through 18 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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)) BOARD OF PATENT
ANITA PELLMAN GROSS) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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)
STUART S. LEVY)
Administrative Patent Judge)

APG/rwk

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